

Appn No. 09/575,165
 Amdt. Dated March 6, 2006
 Response to Office Action of January 27, 2006

6

REMARKS/ARGUMENTS

Applicant thanks Examiner for the detailed Final Office Action of January 27, 2006. The Office Action has been carefully considered. It is respectfully submitted that the issues raised are traversed, being hereinafter addressed with reference to the relevant headings appearing in the Detailed Action section of the Office Action.

Specification

The Examiner has objected that the amendment filed 24 January 2005 as it introduces new matter into the disclosure. The Applicant respectfully disagrees. This issue is dealt with under the next section of the Applicant's response.

Claim Rejections – 35 USC § 112

The Examiner has rejected claims 25-54 as failing to comply with the written description requirement. The Examiner has stated that the term "reference points" has not been defined in the specification.

The Applicant respectfully submits that the term "reference points" is clearly defined in the form of tags in both the specification and the drawings, such that a person skilled in the art would be able to determine the scope of the claims.

As stated in the MPEP, the test for definiteness under 35 U.S.C. 112 second paragraph, is whether "*those skilled in the art would understand what is claimed when the claim is read in light of the specification.*" (in reference to *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986); see MPEP 2173.02).

Accordingly, the meaning of "reference points" in claim 25 should be interpreted in view of the specification. The Applicant highlighted numerous references in the previous Office Action where reference points in the form of tags were described. For instance, page 13 lines 23 to 25 state:

"Each reference to the page description is encoded in a printed tag. The tag identifies the unique page on which it appears, and thereby indirectly identifies the page description. The tag also identifies its own position on the page."

Furthermore, the Applicant highlighted lines 28 to 31 of page 27 in the previous response. This section of the specification states:

"The pen determines the position and orientation of its nib on the netpage by imaging, in the infrared spectrum, an area 193 of the page in the vicinity of the nib. It decodes the nearest tag and computes the position of the nib relative to the tag..."

It would be clear to a person skilled in the art that the tags which indicate a position based on the above highlighted sections of the specification, are functionally equivalent to the reference points. When these sections of the specification are compared to claim 1 in its entirety it can be seen that there are clear indications that the reference points are used to determine a position, similar to that described above. Claim 1 states:

"receiving data from the sensing device, the data including the identity and a position of the sensing device relative to at least one of the reference points..."

Appn No. 09/575,165
 Amdt. Dated March 6, 2006
 Response to Office Action of January 27, 2006

7

It is clear based on sections highlighted from pages 13 and 27 that the reference points would be interpreted by the skilled person in the art to be the tags on the page, because the tags are indicative of the identity and the position on the page. The Applicant also draws the Examiner's attention also to Figure 1 where a plurality of tags/reference points represented by integer 4 are shown on the page which also provides further support for the term "reference points".

The Examiner is reminded that a claim should not be rejected simply because of the type of language used to define the subject matter for which protection is sought. This is supported by MPEP 2173.01 which states:

"A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as >any special meaning assigned to a term is clearly set forth in the specification. See MPEP § 2111.01. < Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought."

Although the Applicant has used the alternate expression of "reference points", it is clear what the boundaries of the subject matter for which protection is sought. The Examiner should not simply reject the claim under 35 U.S.C. 112, second paragraph because the specification does not have the exact wording to systematically correspond with the specification. The Examiner should apply the guidelines provided at MPEP 2173.02 which state:

In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. See, e.g., Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000).

In regard to the term "on/of", the Applicant has amended the claim to specify simply "of" as the Examiner has interpreted the two parts of the phrase to have an equivalent meaning.

In regard to the term "substantially", although this is a relative term, the MPEP states at 2173.05(b) "[T]he fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph. Seattle Box Co., v. Industrial Crating & Packing, Inc., 731 F.2d 818, 221 USPQ 568 (Fed. Cir. 1984). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification."

Furthermore, MPEP 2172.05(b) states:

"The term "substantially" is often used in conjunction with another term to describe a particular characteristic of the claimed invention. It is a broad term. In re Nehrenberg, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). The court held that the limitation "to substantially increase the efficiency of the compound as a copper extractant" was definite in view of the general guidelines contained in the specification. In re Mattison, 509 F.2d 563, 184 USPQ 484 (CCPA 1975). The court held that the limitation "which produces substantially equal E and H plane illumination patterns" was definite because one of ordinary skill in the art would know what was meant by "substantially equal." Andrew Corp. v. Gabriel Electronics, 847 F.2d 819, 6 USPQ2d 2010 (Fed. Cir. 1988). (emphasis added)

Appn No. 09/575,165
 Amdt. Dated March 6, 2006
 Response to Office Action of January 27, 2006

8

To simply object to a relative term and state that this term is indefinite without giving any consideration to the context which the relative term is provided in the claim and to ignore what is taught in the specification is in total contrast to what the MPEP states, and the Applicant respectfully draws the Examiner's close attention to these relevant sections of the MPEP and US case law noted above.

The specification refers to invisible coded data with reference to the example of the infrared spectrum. The boundaries of the infrared spectrum and the visible spectrum are not precise or exact. Therefore, the term "substantially" is used to reflect this relativity of what is considered invisible in terms of the specification. As the specification includes such examples referring to the coded data being printed with "infrared-absorptive ink" (see page 13 of the specification), the Applicant respectfully submits that it would be considered definite to a skilled person in the art what is meant by "*substantially invisible in the visible spectrum*". A person skilled in the art would understand the scope and boundaries of the claim in regard to range of the visible spectrum and the purpose which this serves in the context of the specification, which is to ensure that the user can see the visible information on the page yet be unable to see the coded data printed on the page so as to not detract from the visible presentation of the page and to more usefully utilise the area provided by the page.

Reconsideration and withdrawal of the claim rejection is respectfully requested.

Claim Rejections – 35 USC § 102

The Examiner has rejected claims 25-28, 34-36, 38, 39, 42-44, and 48-50 as being anticipated by Izawa et al. (US Patent Number 5,420,406).

Reconsideration and withdrawal of the rejection is respectfully requested.

The Examiner has stated on page 4 that Izawa discloses "*receiving data from a sensing device adapted to sense the coded data (column 5 line 6) and position of the coded data (column 3 lines 22-34)*". The Applicant submits that although this may be the Examiner's interpretation of what is disclosed by Izawa, this is not what is explicitly defined in the claims. Claim 1 states the step of "*receiving data from a sensing device, the data including the identity and position of the sensing device relative to at least one of the reference points*". The Applicant submits that the Examiner has failed to show that Izawa et al. discloses the second half (underlined portion) of the above step.

Column 3, lines 22-34 of Izawa et al. state:

"sensor means and bill memory. The optical sensor produces outputs which are used for validation of a bill. The bar code memory and the bar code comparator are provided in the discriminator means. The discriminator means detects bar code after or before detection of whether or not the document is a genuine bill. A motor encoder is provided to generate pulses in order to detect exact position of the document within the passage. Means may be provided to invalidate the document which is considered not valide. The sensor means includes at least an inlet signal capable of detecting overlapped bills from the amount of light passing through the bill. Accordingly, the bill validator of the present" (emphasis added)

Appn No. 09/575,165
 Amdt. Dated March 6, 2006
 Response to Office Action of January 27, 2006

9

The position which Izawa et al refers to is not the position of the bar code on the page. The position is the position of the document within the passage, which is totally different to the claims. The passage can clearly be seen in Figure 1 of Izawa *et al.* represented by integer 13. Thus the position referred to in Iwaza et al is the position of the document relative to the passage 13.

Claim 1 states:

"the data including the identity and position of the sensing device relative to at least one of the reference points, the data having been generated by the sensing device sensing at least some of the coded data"

The Examiner has given no consideration to what the "position", as claimed, is relative to. The claim explicitly states that the position is the *"position of the sensing device relative to at least one of the reference points"*. Furthermore, claim 1 states that the secure document has *"a plurality of reference point on the document"*. Clearly, even with the broadest interpretation, the position as claimed has the requirement that it is a position of the sensing device relative to the reference points on the document. Furthermore, the term position is extremely clear in light of the specification as tags are described as being indicative of an identity of a position on the interface surface (for example see the above references to tags in the prior rejection), and data is generated by the sensing device and transferred to a processing system which is indicative of a position of the sensing device relative to a tag on the page.

The MPEP states at 2131 that:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). >

Iwaza et al fails to disclose the element of *"receiving data from a sensing device, the data including the identity and a position of the sensing device relative to at least one of the reference points, the data having been generated by the sensing device sensing at least some of the coded data"*.

As each and every element as set forth in the claim has not be found, either expressly or inherently described, in a single prior art reference, the Applicant respectfully submits that the claim is not anticipated by Iwaza et al.

The above arguments also apply to the remaining independent claims.

Reconsideration and withdrawal of the claim rejection is respectfully requested.

Claim Rejections – 35 USC § 103

The Examiner has rejected claims 29, 30-33, 37, 40, 41, 45-47, and 51-54 as being unpatentable over Wang et al (US Patent Number 5,710,419) in view of Izawa.

Firstly we note that the Examiner has stated *"Wang et al ... in view of Izawa"*. The Applicant assumes that the Examiner actually intended to mean *"Izaza in view of Wang et al"* as the Examiner's comments are in regard to modifying the primary reference (Izawa) with what is taught by the second reference (Wang et al.). We would appreciate if the Examiner could

Appln No. 09/575,165
 Amdt. Dated March 6, 2006
 Response to Office Action of January 27, 2006

10

confirm whether this is correct or whether the Applicant has misunderstood the Examiner's claim rejection.

Secondly we note that Wang et al relates to erasable bar codes, where a bar code can be erased from a surface and a new bar code can be printed on the surface. A document which relates to physical erasable data would not be an analogous art for the Applicant's method and system. The current claims are directed towards "*verifying the validity status and/or authenticity information of a secure document*". A skilled person in the art who would like to determine an authenticity of a document would not logically consider providing an erasable bar code, as this would allow an unauthorised user to simply erase the bar code and replace it with different data.

The MPEP states at 2141.01(a)(I) that:

The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); Wang Laboratories Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); (emphasis added)

Wang et al relates to a printing and reading system which prints bar codes using erasable ink. The current application relates to determining the validity status of a secure document. Thus, it is clearly apparent that Wang et al is not a reference in the field of the applicant's endeavor.

Furthermore, the applicant's problem related to verifying the validity status of a secure document. Wang describes a solution which actually hinders the applicant's problem and does not provide a means of verifying the validity status of a secure document as the bar code could easily be changed based on the teachings of Wang et al. Wang would not logically have commended itself to an inventor's attention in considering his problem. Therefore, Wang et al is not reasonably pertinent to the particular problem with which the inventor was concerned.

As both questions as stated at MPEP 2141.01(a)(I) should be answered in the negative considering what Wang et al is actually related to and the context of the Applicant's specification, the Applicant respectfully submits that Wang et al is not an analogous art as defined by the MPEP.

As Wang et al is not in the field of applicant's endeavor, and is not reasonably pertinent to the particular problem with which the inventor was concerned, Wang et al cannot be relied upon as a basis for an obviousness rejection of the applicant's claims, as per *In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)*.

Furthermore, the MPEP states at §2143 "Basic Requirements of a Prima Facie Case of Obviousness" that:

"... three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art

Appln No. 09/575,165
 Amdt. Dated March 6, 2006
 Response to Office Action of January 27, 2006

11

reference (or references when combined) must teach or suggest all the claim limitations."

As the Examiner has relied upon of Izawa *et al.* for disclosing receiving data indicative of a position of the sensing device relative to at least one reference point, which we have noted above is not expressly or inherently described in this reference, the combination of Izawa *et al.* in view of Wang et al would fail to meet the third basic requirement of a *prima facie* case of obviousness. In particular, Izawa in view of Wang fails to teach or suggest all the claim limitations including "*receiving data from a sensing device, the data including the identity and a position of the sensing device relative to at least one of the reference points, the data having been generated by the sensing device sensing at least some of the coded data*". As all three basic requirements of a *prima facie* case of obviousness must be met in order to state that a claim is obvious and therefore reject the claim as unpatentable, the Applicant respectfully requests that this claim rejection be withdrawn as all three basic requirement has not been satisfied.

The above arguments also apply to the remaining independent claims.

Reconsideration and withdrawal of this claim rejection is respectfully requested.

Double Patenting

The Examiner has advised the Applicant on page 6 that if claim 25 was to be found allowable, claim 35 would be objected to as being a substantial duplicate thereof. Although the Applicant appreciates the Examiner's note, we respectfully submit that although the claims appear similar, they cover different scope and should not be objected as double patenting.

Claim 25 recites that the method includes the three steps of recording, receiving, and verifying. Claim 35 recites that the method includes the two steps of receiving and verifying. The recording step may have been performed by a separate entity. This is indicated by the wording "has been recorded in a computer system". As such, the method of claim 35 only requires the two steps to be performed.

MPEP 706.03(k) states:

"Inasmuch as a patent is supposed to be limited to only one invention or, at most, several closely related indivisible inventions, limiting an application to a single claim, or a single claim to each of the related inventions might appear to be logical as well as convenient. However, court decisions have confirmed applicant's right to restate (i.e., by plural claiming) the invention in a reasonable number of ways. Indeed, a mere difference in scope between claims has been held to be enough."

Nevertheless, when two claims in an application are duplicates, or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other claim under 37 CFR 1.75 as being a substantial duplicate of the allowed claim."

The Applicant has the right to restate the method is a reasonable number of ways. The Applicant in this case wishes to state that the method specified in claim 25 can be performed by one entity performing the recording, receiving and verifying steps, whereas the method specified in claim 35 can be performed by performing the receiving and verifying steps wherein the recorded step may have been performed earlier and may not necessarily have been performed by the same entity which performs the other two steps. Claim 25 and claim 35 are "*not so close that they cover the same thing*" as claim 25 requires the recording step to be performed in the method

Appln No. 09/575,165
Amdt. Dated March 6, 2006
Response to Office Action of January 27, 2006

12

whereas claim 35 requires that the recording step has already been performed. Although this is a slight difference, this difference does not amount to conclusion that the claims are "*so close that they cover the same thing*". The Applicant requests that the Examiner reconsider the potential double patenting rejection based on the above arguments.

Other Voluntary Amendments

The Applicant has also introduced an amendment to claim 43. Support for this feature can be found in claim 25. The Applicant submits that this amendment introduces no new subject matter.

In view of the foregoing, it is respectfully requested that the Examiner reconsider and withdraw the rejections. The present application is believed to be in condition for allowance. Accordingly, the Applicant respectfully requests a Notice of Allowance of all the claims presently under examination.

Very respectfully,

Applicant:

KIA SILVERBROOK

Applicant:

PAUL LAPSTUN

C/o: Silverbrook Research Pty Ltd
393 Darling Street
Balmain NSW 2041, Australia

Email: kia.silverbrook@silverbrookresearch.com

Telephone: +612 9818 6633

Facsimile: +61 2 9555 7762